

### **REMARKS**

The Applicant notes with appreciation the Examiner's thorough review of the present application as evidenced by the Office Action. In response, the Applicant has amended the claims to more clearly recite the invention. The Applicant has also provided remarks below, in response to the rejections in the Office Action. In light of the amendments above and the remarks that follow, the Applicant respectfully submits that all the claims of the application are patentable and in condition for allowance.

### **REISSUE DECLARATION**

The Examiner rejected all claims on the grounds that the reissue declaration filed with the application is defective.

A Supplemental Reissue Declaration satisfying the statutory requirements is being submitted herewith, along with a cover sheet entitled, "Submission of Supplemental Declaration for Reissue Patent Application."

### **CLAIM AMENDMENTS**

Claims 22-31 were filed by preliminary amendment in this continuation application.

Claims 32-44 were submitted in response to an Office Action.

In independent claim 32, after the phrase "for manufacturing thermoplastic containers," please insert the phrase – **said machine comprising two mold carriers which can move with respect to each other, said mold carriers supporting two shell holders including pipes and connections for the circulation of cooling and/or heating fluids, said shell holders defining a cavity for receiving said mold shell, said mold shell –**. Also, after the phrase "at least two axial positioning assemblies, please insert the phrase – **positioned along said shell body –**. Finally, in three instances within claim 32, please replace "said machine" with – **said shell holders –**.

In claim 35, please replace "said machine" with – **said shell holders –**.

In claim 37, please replace "a mold carrier" with – **said mold carriers –**.

In independent claim 38, after the phrase “for manufacturing thermoplastic containers,” please insert the phrase – **said machine comprising two mold carriers which can move with respect to each other, said mold carriers supporting two shell holders including pipes and connections for the circulation of cooling and/or heating fluids, said shell holders defining a cavity for receiving said mold shell, –**. In the subparagraph beginning “an outer wall,” please replace “said machine;” with – **said shell holders; and –**. Before the phrase “at least two axial positioning assemblies,” please insert the phrase – **wherein said shell body comprises –**. Before the phrase “one or more bearing surfaces,” please insert the phrase – **wherein said shell body comprises –**. After the phrase “one or more bearing surfaces,” please delete the phrase – **each positioned along said shell body and –**. Finally, in two instances within claim 38, please replace “said machine” with – **said shell holders –**.

In claim 41, please replace “said machine” with – **said shell holders –**.

### **CLAIMS 32-44**

The Examiner rejects newly-entered claims 32-44 on the grounds that the claims attempt to recapture subject matter that was surrendered in an amendment to original claim 1 that was submitted on September 28, 1998 (“the September Amendment”) in the original application for patent. The newly-entered claims 32-44 (as amended), however, recite subject matter that was identified as allowable in an Office Action dated June 21, 1998 – before the September Amendment to independent claim 1. Because newly-entered claims 32-44 recite subject matter that was deemed allowable before the September Amendment, there is no recapture.

A copy of the Office Action dated June 21, 1998 (the “June Office Action”) is attached hereto as Exhibit A. On page 7 of the June Office Action, the Examiner identified the allowable subject matter to include original claims 3, 9, 10 and 12; provided, they were rewritten to overcome the Section 112 rejections and to include all the limitations of the base claim [claim 1] and any intervening claims. A copy of original claims 1, 3, 9, 10, and 12 is attached hereto as Exhibit B, for reference.

The allowability of claims 3, 9, 10, and 12, as expressed in the June Office Action, was in no way contingent upon any changes or amendments to claim 1. Accordingly, in response to the June Office Action, the applicant could have submitted claims reciting the allowable subject matter – correcting the Section 112 rejections and including the limitations of the base claim and intervening claims – without amending any part of independent claim 1.

The newly-entered claims 32-44 recite the allowable subject matter that could have been claimed by the applicant in the original application. Claims 32-37 recite a mold shell for use with a machine having the allowable features. Claims 38-44 recite a shell body for use with a machine having the allowable features. Because the applicant had a right to claim these allowed features in the original application, the applicant submits these claims for reissue.

Below is a side-by-side comparison of the allowed subject matter allowed in the June Office Action and the subject matter of the newly-entered independent claims, 32 and 38:

Allowed Subject Matter as of June 21, 1998, in Original Claims 1, 3, 9, 10, and 12	Elements Recited in Claim 32 (as Amended)
<p><b>[1]</b> Device or Machine;</p> <p><b>[2]</b> Two Mold Carriers which can move one with respect to the other;</p> <p><b>[3]</b> Two Shell Holders, including pipes for circulation of fluids;</p> <p><b>[4]</b> Shell, defining a half-impression of the container, the shell removably fastened to its shell holder by quick-fixing means (Claims 1 and 9);</p> <p><b>[5]</b> wherein shell and shell holder are in at least partial mutual thermal-conduction contact (Claims 1 and 3).</p>	<p>32. A mold shell <b>[4]</b> for use with a machine <b>[1]</b> for manufacturing thermoplastic containers, said machine comprising two mold carriers <b>[2]</b> which can move with respect to each other, said mold carriers supporting two shell holders <b>[3]</b> including pipes and connections for the circulation of cooling and/or heating fluids, said shell holders defining a cavity for receiving said mold shell, said mold shell comprising:</p> <p style="padding-left: 40px;">a shell body defining an impression <b>[4]</b> of a substantial portion of a container to be manufactured, and defining an outer wall shaped to be in at least partial mutual thermal-conduction contact <b>[5]</b> with said shell holders;</p> <p style="padding-left: 40px;">a mold bottom defining a base impression of a base portion of the container to be manufactured;</p> <p style="padding-left: 40px;">at least two axial positioning assemblies positioned along said shell body by which said shell body may be fixed in an axial direction with respect to said shell holders; and</p> <p style="padding-left: 40px;">one or more bearing surfaces positioned along said shell body and sized and shaped to receive a quick-fixing locking member <b>[4]</b> for releasably securing said shell body to said shell holders.</p>

Allowed Subject Matter as of June 21, 1998, in Original Claims 1, 3, 9, 10, and 12	Elements Recited in Claim 38 (as Amended)
<p><b>[1]</b> Device or Machine;</p> <p><b>[2]</b> Two Mold Carriers which can move one with respect to the other;</p> <p><b>[3]</b> Two Shell Holders, including pipes for circulation of fluids;</p> <p><b>[4]</b> Shell, defining a half-impression of the container, the shell removably fastened to its shell holder by quick-fixing means (Claims 1 and 9);</p> <p><b>[5]</b> wherein shell and shell holder are in at least partial mutual thermal-conduction contact (Claims 1 and 3).</p>	<p>38. A shell body for use with a mold bottom to form a mold shell <b>[4]</b>, the mold shell for use with a machine <b>[1]</b> for manufacturing thermoplastic containers, said machine comprising two mold carriers <b>[2]</b> which can move with respect to each other, said mold carriers supporting two shell holders <b>[3]</b> including pipes and connections for the circulation of cooling and/or heating fluids, said shell holders defining a cavity for receiving said mold shell, the shell body comprising:</p> <p>an outer wall shaped in order to be in at least partial mutual thermal-conduction contact <b>[5]</b> with said shell holders; and</p> <p>an impression <b>[4]</b> of a substantial portion of a container to be manufactured;</p> <p>wherein said shell body comprises at least two axial positioning assemblies by which said shell body may be fixed in an axial direction with respect to said shell holders; and</p> <p>wherein said shell body comprises one or more bearing surfaces sized and shaped to receive a quick-fixing locking member <b>[4]</b> for releasably securing said shell body to said shell holders-</p>

Because newly-entered claims 32-44 recite the allowable subject matter that could have been claimed by the applicant in the original application, before the September Amendment, the applicant may seek issuance of these claims in reissue without raising any recapture issue.

## CLAIM REJECTIONS – RECAPTURE

### I. THE REISSUE CLAIMS DO NOT RECAPTURE SURRENDERED SUBJECT MATTER BECAUSE THE MOLD CARRIER SHAPE CONTINUES TO BE A REQUIRED CHARACTERISTIC OF THE CLAIMED ARTICLE.

The recapture rule does not bar the reissue claims because the narrowing amendment (the mold carrier shape) continues to be a required characteristic of the article in the reissue claims. The recapture rule “prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.” *Ex parte Eggert*, 67 U.S.P.Q.2d 1716, 2003 WL 21542454, at \*11 (BD. PAT. APP. & INTERF. May 29, 2003), *quoting In re Clement*, 131 F. 3d 1464, 1468 (Fed. Cir. 1997). Analysis of the pending reissue claims using the *Clement* test confirms there is no recapture. The reissue claims are narrower because the mold carrier shape continues to be required, and broader because the claims recite an article of manufacture that corresponds to the machine claims in the patent.

The *Clement* recapture test includes two steps. First, whether the reissue claims are broader than the surrendered subject matter and in what respect. Second, whether those broader aspects of the reissue claims relate to the surrendered subject matter. The second step requires analysis of the subject matter surrendered and whether the broadening aspect relates to the surrendered subject matter. The court in *Clement* stated the following principles:

- (1) if the reissue claim is as broad as or broader than the canceled or amended claim [the surrendered subject matter] in all aspects, the recapture rule bars the claim;
- (2) if it is narrower [than the surrendered subject matter] in all aspects, the recapture rule does not apply, but other rejections are possible;
- (3) if the reissue claim is broader [than the surrendered subject matter] in some aspects, but narrower [than the surrendered subject matter] in others, then:
  - (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;

(b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

*Eggert* at \*13, *quoting Clement* at 1469-70. Applying the *Clement* test here, the pending reissue claims are an example of principle (3)(b) and the recapture rule therefore does not bar the claims.

**A. The Reissue Claims Are Narrower Than the Surrendered Subject Matter, In an Aspect Germane to the Rejection.**

The reissue claims are narrower because the mold carrier shape continues to be a required characteristic. Under the principles enumerated in *Clement*, category (3)(b) applies, “if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection” and the recapture rule does not bar the claim. *Eggert* at \*13, *quoting Clement* at 1469-70. Because the mold carrier shape continues to be a required characteristic, the reissue claims are narrower than the surrendered subject matter.

The subject matter surrendered during prosecution of the machine claim was: a device without the enveloping characteristic of the mold carriers. Claim 1 was amended to add the phrase, “which are made in the form of enveloping structures.” The original claim 1 and the amendment made during prosecution are shown below:

Original Independent Claim 1 of the '089  
Application Read as Follows:

Device for manufacturing containers, in particular bottles, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform,

the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which can move one with respect to the other, characterized in that each half-mold (2) comprises

a shell holder (9) supported by the respective mold carrier (3) and

a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23),

the shell (7) and the shell holder (9) being of complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

In traversing the obviousness rejection, the Applicant argued, “neither *Appel* nor *Schavoir* teach or suggest . . . an enveloping mold carrier . . . .” (Amendment at 7). The amendment and traversal of the prior art rejection represents a surrender of a device that does not include the enveloping characteristic of the mold carriers.

The Examiner argues the reissue claims constitute recapture because the mold carrier shape is recited as a characteristic of the shell holders instead of as a separate structural element.

Independent Claim 1 after the only  
Amendment in the '089 Application and Issued  
as Claim 1 of the '560 Patent (deletions in  
strikeout; additions in bold):

Device for manufacturing containers, in ~~particular bottles,~~ made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform,

the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) **which are made in the form of enveloping structures** and which can move one with respect to the other, characterized in that each half-mold (2) comprises

a shell holder (9) supported by the respective mold carrier (3) and

a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23),

the shell (7) and the shell holder (9) being of complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.



Referring to Claim 1 in the table above, however, shows that the claim amendment includes only the mold carrier shape: “made in the form of enveloping structures.” The two mold carriers were already present in the claim.

In support of the recapture position, the Examiner has cited *Pannu v. Storz Instruments*, 258 F.3d 1366 (Fed. Cir. 2001). In *Pannu*, the Applicant limited the shape of the claimed haptics by adding the new phrase “continuous, substantially circular arc” to claim 16. *Pannu* at 1371. The reissue claims eliminated the new phrase and instead claimed haptics having a length “substantially greater . . . [to] at least three times greater” than the width. *Id.* at 1372.

The Examiner’s argument that the “two mold carriers” were the surrendered subject matter is not supported by *Pannu* because the haptics in *Pannu* were not surrendered in order to overcome the prior art rejection. Instead, the surrendered subject matter was: any haptics not having the characteristic new shape of a “continuous, substantially circular arc.” The haptics element itself was not the surrendered subject matter in *Pannu*. Only the shape was limited. The haptics were already present in the claim. Thus, the facts of *Pannu* do not support the Examiner’s argument that the “two mold carriers” were surrendered in this case. The two mold carriers were present before and after the amendment.

The reissue claims are narrower than the surrendered subject matter because “shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures” adds the same limitation on the mold carrier shape, now as a characteristic of the shell holders. Below is a comparison of patent claim 1 and reissue claim 15. (Reissue claims 15, 35, 36, and 39 all include the same mold carrier shape limitation).

Issued Claim 1 of the '560 Patent  
(amendments shown; deletions in strikeout;  
additions in bold):

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Device for manufacturing containers, ~~in particular bottles,~~ made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including

at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) **which are made in the form of enveloping structures** and which can move one with respect to the other,

characterized in that each half-mold (2) comprises

a shell holder (9) supported by the respective mold carrier (3) and

a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23),

the shell (7) and the shell holder (9) being of complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

Because the characteristic shape is still required, the reissue claims are narrower than the rejected claim in an aspect germane to the prior art rejection.

The distinguishing characteristic of "mold carriers made in the form of enveloping structures" is present in both the patent claim and the reissue claims. The mold carrier shape continues to be required in the reissue claims. The Applicant did not surrender the option of

New Claim 15 of the Reissue Application,  
after Amendment, compared to Issued Claim 1  
(addition in bold):

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A mold assembly for use in manufacturing molded thermoplastic containers comprising:

two mold shells each containing a half-impression of a substantial portion of the container to be molded;

two mold shell holders each defining a cavity for receiving each said respective mold shell such that each said respective mold shell is in at least partial mutual thermal-conduction contact with its respective shell holder, **said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures** movable one with respect to the other; and

at least one quick-fixing locking member by which at least one of said mold shells is removably secured to a respective one of said mold shell holders, said one quick-fixing locking member including a selectively retractable locking member portion.

claiming the same invention as an article of manufacture instead of a machine. Because the distinguishing characteristic continues to be required in the reissue claims, and because the mold carrier shape represents the same limitation that was added when the patent claim was amended, the reissue claims are narrower than the surrendered subject matter, in an aspect germane to the prior art rejection.

**B. The Reissue Claims Are Broader Than the Surrendered Subject Matter, In an Aspect Unrelated to the Rejection.**

The reissue claims are broader because they recite an article of manufacture corresponding to the machine claimed in the issued patent. Under the *Clement* recapture test, the first question is whether the reissue claims are broader than the surrendered subject matter and in what respect. *Clement* at 1468. Claiming an invention in a different statutory category is a broadening reissue, *see* MPEP § 1412.02, but in the present case, the shift in statutory category is unrelated to the prior art rejection made during prosecution.

The reissue claims recite the same patentable subject matter as the patent claim, but in a different statutory category. The patent claim recites a “device for manufacturing containers,” which is a machine under 35 U.S.C. § 101.<sup>1</sup> The reissue claims recite a “mold assembly,” which is a manufacture (or article of manufacture) under Section 101.<sup>2</sup>

A patentee may file a reissue application to permit consideration of claims written in a different statutory category where the reissue claims correspond to the patented claims. MPEP § 1412.02. The following paragraph of Section 1412.02 explains that the consideration of claims, presented in a different category, is proper in a reissue application:

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<sup>1</sup> “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101.

<sup>2</sup> The Examiner argues that the mold assembly is not a separate statutory category, but is a subcombination in relation to the manufacturing device of Claim 1. The Applicant disagrees. The Examiner has cited no support for a conclusion that a subcombination cannot be a separate statutory category. A computer-readable medium containing software, such as a hard drive, is a good example of

MPEP § 1412.02. Reissue for Article Claims Which Are Functional Descriptive Material Stored on a Computer-Readable Medium.

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the “article” claims) must have been made as a result of error without deceptive intent. The addition of these “article” claims will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

MPEP § 1412.02 (emphasis in original). This paragraph of Section 1412.02 addresses the “statutory category change” situation in terms of seeking article claims (for the code on a drive) that correspond to the patented machine or process claims (for the software process). Similarly, here, the reissue claims being sought are article claims (for the mold assembly) that correspond to the patented machine claims (for the manufacturing device).

In the example described in Section 1412.02, the patented claims for a software process may include several steps, positively recited. For example, a software process claim may include, “storing said value in a database.” The article claims for the “functional descriptive material stored on a computer-readable medium” being sought in reissue may include, “said computer-readable medium configured to store said value in a database.” The step of storing is not positively recited in the article claims. Nevertheless, the medium must be configured to carry out the storing step. The article claims may be properly sought in a reissue application if the error was made without deceptive intent.

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an article of manufacturer that might be considered a subcombination of a computing machine. *Compare* MPEP § 1412.02, discussed below.

Applying Section 1412.02 to the present case, the patented machine claim for a “device for manufacturing containers” includes several elements, positively recited:

“at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which are made in the form of enveloping structures . . . .”

(U.S. Patent No. 5,968,560, Claim 1). The article claims for the “mold assembly” being sought in reissue include:

“two mold shell holders . . . said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures . . . .”

(Reissue Application, Claim 15). Like the step of storing in the software example, the two mold carriers are not positively recited in the article claims. Nevertheless, the mold assembly must include shell holders configured to be supported by two mold carriers having an enveloping shape.

The shift in statutory category is unrelated to the prior art rejection made during prosecution for several reasons. First, the Applicant did not surrender the option of seeking corresponding article claims. The article claims may be properly sought in this reissue application because the error of not pursuing claims to the mold assembly article along was made without deceptive intent. The Reissue Declaration expressly cites the lack of article claims such as “to the mold shells standing alone” as an error sought to be corrected through reissue.

Second, the presentation of article claims cannot be germane to the prior art rejection because the Examiner admitted the article claims are patentable over the prior art. The Applicant and the Examiner agree that all the article claims are patentably distinguishable and allowable over the prior art.

The reissue claims are broader because they claim the invention in a different statutory category. The shift in statutory category is unrelated to the prior art rejection because the option of seeking corresponding article claims was not surrendered.

The recapture rule, therefore, does not bar the claim. Under the *Clement* test and *Ex parte Eggert*, if the reissue claims are broader than the surrendered subject matter in some aspects and narrower than the surrendered subject matter in other respects, and if the reissue claim is narrower in an aspect germane to the prior art rejection and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim. *Eggert* at \*13; *Clement* at 1469-70. Applying this test to the pending reissue claims:

- The reissue claims are narrower than the patent claim prior to amendment (*i.e.*, narrower than the surrendered subject matter) in that the same enveloping characteristic of the mold carrier continues to be required in the reissue claims.
- The reissue claims are broader than the surrendered subject matter because the reissue claims are directed to an article of manufacture instead of a machine. *See* MPEP § 1412.02.
- The narrowing aspect (continuing to require the enveloping characteristic of the mold carriers) is germane to the rejection because the shape was limited by amendment and remains a required limitation in the reissue claims.
- The broadening aspect (claiming the article corresponding to the machine) is not germane to the rejection, because a change in statutory category is germane to the rejection, and the article claim is patentable over the prior art as determined by the Examiner in the reissue.

Accordingly, under *Clement* and *Ex parte Eggert*, the requirements of paragraph 3(b) of *Clement* test are satisfied and the recapture rule does not bar the reissue claims.

### CONCLUSION

After entry of the requested amendment, claims 21-44 are pending in the application. In light of the amendments and the remarks presented, the Applicant respectfully submits that all the claims of the application are patentable and the application is now in condition for allowance.

The Applicant submits herewith a Submission of Supplemental Declaration for Reissue Patent Application.

The Applicant also submits herewith a Petition and Fee for Extension of Time, along with the required fee. The Applicant does not believe any fees for extensions of time or net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. In the event additional extensions of time are necessary to allow the consideration of this paper, such extensions are hereby petitioned-for under 37 CFR § 1.136(a) and any required fees (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account Number 16-0605.

The undersigned is available at (404) 881-7821 if the Examiner has any questions or requests that may be resolved by telephone in order to expedite the examination.

Respectfully submitted,




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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to **Mail Stop Reissue**, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on this, the 7<sup>th</sup> day of March, 2005.

  
Shana Moore

## EXHIBIT A

A copy of the Office Action dated June 21, 1998  
(the “June Office Action”).





**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>08/945,089</b>	Applicant(s) <b>Briere et al</b>	
	Examiner <b>Robert Davis</b>	Group Art Unit <b>1722</b>	

☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) 1-13 \_\_\_\_\_ is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-13 \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Oct 17, 1997 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number: 08/945,089

Page 2

Art Unit: 1722

### DETAILED ACTION

#### *Specification*

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
2. The disclosure is objected to because of the following informalities:  
On line 10 of page 8, "Figure 3" should be "Figure 2".  
On line 14 of page 8, "two ribs 18" should be "two ribs 16" to match figure 2.  
Appropriate correction is required.

#### *Drawings*

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the pressure compensation means being a chamber and an o-ring as claimed by means of the 112 6th language in claim 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

#### *Claim Rejections - 35 USC § 112*

4. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Serial Number: 08/945,089

Art Unit: 1722

On line 3 of claim 10, the phrase "'jackknife"-type mold" is indefinite. First the quotes should be removed from around the term jackknife. Second, "[T]he word 'type' when appended to an otherwise definite expression so extends the scope of such expression as to render it objectionably indefinite from the standpoint of patent law and procedure.", *Ex parte Copenhaver*, 109 USPQ 118.

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation containers, and the claim also recites in particularly bottles which is the narrower statement of the range/limitation.

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*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 2, 4, 7, 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appel et al (4,072,456: figures 10-12; column 11, lines 36-57 and column 12, lines 8-27) taken together with Schavoir (1,409,591: figures 1-4; page 1, lines 88-99 and page 2, lines 63-68).

Appel et al disclose a blow molding device for manufacturing bottles comprising: two half molds (43, 44) which include two semi-cylindrical shells (130,131) which form the mold cavity and means to move the molds (120,121) wherein the a cooling system is supplied which does not require exchange of cooling system supply connections when changing the mold inserts (column 12, lines 13-26). The reference discloses mounting flanges (140,141). The reference

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does not disclose quick fixing means per se or the shell and molds having thermal conduction contact.

Schavoir discloses a molding device comprising inserts (22) made of a soft metal and connected to support molds (10,11) by quick fixing means (26,28). The reference also shows that the inserts are in thermal conduction contact with the support molds.

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the apparatus of Appel et al by having an insert in thermal conduction contact with a mold support by means of quick fixing means as disclosed by Schavoir because the thermal conduction contact provides a much cleaner operation than the cooling channel of Appel et al which must be emptied of liquid before exchanging inserts. It would have been further obvious to use the quick fixing means to decrease the down time of the apparatus while changing mold inserts to form differently shaped articles.

8. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appel et al taken together with Schavoir as applied to claims 1, 2, 4, 7, 8 and 13 above, and further in view of Turner et al (3,753,641: figure 2).

The combination of Appel et al and Schavoir disclose all claimed features except for the use of positioning means between the shell and mold.

Turner et al disclose a blow mold having a shell (21) and a supporting mold (10) wherein a ledge as shown in figure 2 positions the parts in respect to one another.

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It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the apparatus of the combination by using a positioning means as disclosed by Turner et al as such means were well known in the art as aids in assembling multi-part molds to avoid damage to the mold upon clamping due to improper alignment. It would have been further obvious to use a rib and mating groove as such was well known mold and insert aligning means which provide better alignment than the positioning means of Turner et al.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Appel et al taken together with Schavoir as applied to claims 1, 2, 4, 7, 8 and 13 above, and further in view of Abramam (5,332,384: figures 1, 2 and 5).

The combination of Appel et al and Schavoir disclose all claimed features except for the means for guiding the mold halves together.

Abramat discloses means (20,30) for aligning opposing mold halves.

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the apparatus of Appel et al by using mold half aligning means as disclosed by Abramam to prevent damage improperly aligned molds during clamping and to prevent the likelihood of molding improperly shaped articles which must be recycled or scrapped.

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*Allowable Subject Matter*

10. Claims 3, 9, 10 and 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. The following is an examiner's statement of reasons for allowance: None of the prior art of record teach or suggest the shell being in partial thermal conduction contact for differentially treating the material as claimed in claim 3. In regards to claim 9, none of the prior art of record teach or suggest quick fixing means which comprises a stop on one side of then quick screwing means on the other side of the parting face. In regards to claim 12, none of the prior art of record teach or suggest pressure compensating means being a chamber and o-ring seal.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The remaining references show various mold inserts and blow molding apparatus.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Davis whose telephone number is (703) 308-2625. The examiner can normally be reached on Monday thru Friday from 8 AM to 4 PM.



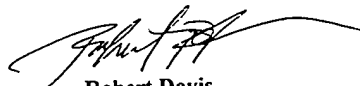
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan, can be reached on (703) 308-2383. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Robert Davis  
Primary Examiner  
Art Unit 1722

6/21/98

<b>Notice of References Cited</b>				Application No. 08/945,089		Applicant(s) Briere et al	
				Examiner Robert Davis		Group Art Unit 1722	

U.S. PATENT DOCUMENTS						
	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	
A	467,881	1/1892	Fisher	249	102	
B	1,409,591	3/1922	Schavoir	249	102	
C	3,191,225	6/65	Polka	425	541	
D	3,753,641	8/73	Turner et al	425	541	
E	3,784,344	1/74	Korsch	425	526	
F	4,072,456	2/78	Appel et al	425	183	
G	5,288,222	2/94	Wieser	425	192R	
H	5,332,384	7/94	Abramat	425	522	
I	5,346,386	9/94	Albrecht et al	425	541	
J	5,358,396	10/94	Antonius Giesen	425	192R	
K						
L						
M						

FOREIGN PATENT DOCUMENTS						
	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
N	2,057,196	5/71	France	---	249	102
O	2,653,058	4/91	France	---	425	522
P						
Q						
R						
S						
T						

NON-PATENT DOCUMENTS	
	DATE
U	
V	
W	
X	

8/94/089

NOTICE OF DRAFTPERSON'S  
PATENT DRAWING REVIEW

The drawing filed (insert date)

10/17/97

are:

A. ☒ not objected to by the Draftperson under 37 CFR 1.84 or 1.152.B. ☐ objected to by the Draftperson under 37 CFR 1.84 or 1.152 as indicated below. The Examiner will require submission of new, corrected drawings when necessary. Corrected drawings must be submitted according to the instructions on the back of this notice.1. DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings:  
Black ink. Color.

- ☐ Color drawing are not acceptable until petition is granted.  
Fig.(s) \_\_\_\_\_  
☐ Pencil and non black ink is not permitted. Fig(s) \_\_\_\_\_

## 2. PHOTOGRAPHS. 37 CFR 1.84(b)

- ☐ Photographs are not acceptable until petition is granted.  
☐ 3 full-tone sets are required. Fig(s) \_\_\_\_\_  
☐ Photographs not properly mounted (must bristol board or photographic double-weight paper). Fig(s) \_\_\_\_\_  
☐ Poor quality (half-tone). Fig(s) \_\_\_\_\_

## 3. TYPE OF PAPER. 37 CFR 1.84(c)

- ☐ Paper not flexible, strong, white and durable.  
Fig.(s) \_\_\_\_\_  
☐ Erasures, alterations, overwritings, interlineations, folds, copy machine marks not acceptable. (too thin)  
☐ Mylar, vellum paper is not acceptable (too thin).  
Fig(s) \_\_\_\_\_

## 4. SIZE OF PAPER. 37 CFR 1.84(f): Acceptable sizes:

- ☐ 21.0 cm by 29.7 cm (DIN size A4)  
☐ 21.6 cm by 27.9 cm (8 1/2 x 11 inches)  
☐ All drawings sheets not the same size.  
Sheet(s) \_\_\_\_\_

## 5. MARGINS. 37 CFR 1.84(g): Acceptable margins:

- ☐ Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm  
SIZE: A4 Size  
☐ Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm  
SIZE: 8 1/2 x 11  
☐ Margins not acceptable. Fig(s) \_\_\_\_\_  
☐ Top (T) \_\_\_\_\_ Left (L) \_\_\_\_\_  
☐ Right (R) \_\_\_\_\_ Bottom (B) \_\_\_\_\_

## 6. VIEWS. CFR 1.84(h)

REMINDER: Specification may require revision to correspond to drawing changes.

- ☐ Views connected by projection lines or lead lines.  
Fig.(s) \_\_\_\_\_

Partial views. 37 CFR 1.84(h)(2)

- ☐ Brackets needed to show figure as one entity.  
Fig.(s) \_\_\_\_\_  
☐ Views not labeled separately or properly.  
Fig.(s) \_\_\_\_\_  
☐ Enlarged view not labeled separately or properly.  
Fig.(s) \_\_\_\_\_

## 7. SECTIONAL VIEWS. 37 CFR 1.84(h)(3)

- ☐ Hatching not indicated for sectional portions of an object.  
Fig.(s) \_\_\_\_\_  
☐ Sectional designation should be noted with Arabic or Roman numbers. Fig(s) \_\_\_\_\_

## 8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)

- ☐ Words do not appear on a horizontal, left-to-right fashion when page is either upright or turned, so that the top becomes the right side, except for graphs. Fig.(s) \_\_\_\_\_  
☐ Views not on the same plane on drawing sheet. Fig.(s) \_\_\_\_\_

## 9. SCALE. 37 CFR 1.84(k)

- ☐ Scale not large enough to show mechanism with crowding when drawing is reduced in size to two-thirds in reproduction.  
Fig.(s) \_\_\_\_\_

## 10. CHARACTER OF LINES, NUMBERS, &amp; LETTERS. 37 CFR 1.84(l)

- ☐ Lines, numbers & letters not uniformly thick and well defined, clean, durable and black (poor line quality).  
Fig.(s) \_\_\_\_\_

## 11. SHADING. 37 CFR 1.84(m)

- ☐ Solid black areas pale. Fig.(s) \_\_\_\_\_  
☐ Solid black shading not permitted. Fig(s) \_\_\_\_\_  
☐ Shade lines, pale, rough and blurred. Fig.(s) \_\_\_\_\_

## 12. NUMBERS, LETTERS, &amp; REFERENCE CHARACTERS. 37 CFR 1.84(p)

- ☐ Numbers and reference characters not plain and legible.  
Fig.(s) \_\_\_\_\_  
☐ Figure legends are poor. Fig.(s) \_\_\_\_\_  
☐ Numbers and reference characters not oriented in the same direction as the view. 37 CFR 1.84(p)(3) Fig.(s) \_\_\_\_\_  
☐ English alphabet not used. 37 CFR 1.84(p)(3) Fig.(s) \_\_\_\_\_  
☐ Numbers, letters and reference characters must be at least .32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3) Fig.(s) \_\_\_\_\_

## 13. LEAD LINES. 37 CFR 1.84(q)

- ☐ Lead lines cross each other. Fig.(s) \_\_\_\_\_  
☐ Lead lines missing. Fig.(s) \_\_\_\_\_

## 14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.84(r)

- ☐ Sheets not numbered consecutively, and in Arabic numerals beginning with number 1. Fig.(s) \_\_\_\_\_

## 15. NUMBERING OF VIEWS. 37 CFR 1.84(u)

- ☐ Views not numbered consecutively, and in Arabic numerals beginning with number 1. Fig.(s) \_\_\_\_\_

## 16. CORRECTIONS. 37 CFR 1.84(w)

- ☐ Corrections not made from PTO-948 dated \_\_\_\_\_

## 17. DESIGN DRAWINGS. 37 CFR 1.152

- ☐ Surface shading shown not appropriate. Fig.(s) \_\_\_\_\_  
☐ Solid black shading not used for color contrast.  
Fig.(s) \_\_\_\_\_

COMMENTS

1.16 2/11/98

## EXHIBIT B

### Original Claims 1, 3, 9, 10, and 12

1. Device for manufacturing containers, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which can move one with respect to the other, characterized in that each half-mold (2) comprises a shell holder (9) supported by the respective mold carrier (3) and a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23), the shell (7) and the shell holder (9) being in complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

3. Device according to claim 1, characterized in that the mating faces (14, 15) of the shell (7) and of the shell holder (9) are in partial thermal-conduction contact by leaving regions of limited thermal conduction.

4. Device according to claim 1, characterized in that the mutually contacting mating faces (14, 15) of the shell (7) and of the shell holder (9) are approximately semicylindrical surfaces of revolution with an axis approximately parallel to the axis of the impression (8) of the container to be manufactured.

8. Device according to Claim 4, characterized in that the means (19-23) for quickly fixing the shell and the shell holder are located on their respective edges parallel to the axis of the impression.

9. Device according to claim 8, characterized in that the quick-fixing means (19-23) comprise, on one side, at least one stop for positioning the parting face of the shell with respect to the parting face of the shell holder and, on the other side, quick-screwing means (23) on the parting face (18) of the shell holder (9) with a clamping surface (21) projecting from the parting face (19) of the shell.

10. Device according to claim 9, in which the mold carriers are rotationally pivoted with respect to each other whereby at least one stop is located on the pivot (4) side of the mold carriers (3) and the quick-screwing means are located on the opposite side.

12. Device according to claim 1, characterized in that at least one of the shell holders is equipped with pressure-compensating means suitable for maintaining the sealed closure of the mold during blow molding.

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